

REMARKS

At the outset, Applicant respectfully submits that the pending Notice of Non-Responsive Amendment unnecessarily protracts prosecution of the above-identified application. In the Notice of Non-Responsive Amendment, the Examiner declined to enter the Amendment because dependent claim 36 was not expressly addressed. M.P.E.P. § 714.03 is directly on point, and states “[w]here an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action but contains a minor [emphasis added] deficiency (e.g., fails to treat every rejection), the examiner may simply act on the amendment and issue a new Office action.” As the Amendment dated November 21, 2006 was not considered on the merits, any subsequent Office Action should be made Non-Final.

Summary of the Office Action

Claims 18, 33, and 38 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Claim 38 stands rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,970,260 to *Roosen et al.*

Claims 18-28, 30-32, and 35-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,782,402 to *Hidaka et al.* in view of *Roosen et al.*

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hidaka et al.* in view of U.S. Patent No. 6,289,378 to *Meyer et al.*

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hidaka et al.* in view of *Roosen et al.* in further view of U.S. Patent No. 6,182,123 to *Filepp et al.*

Summary of the Response to the Office Action

Claims 18, 33, 35, and 37 have been amended. No new matter has been introduced.

Applicant respectfully traverses the rejection of claim 38 under 35 U.S.C. § 112, first paragraph.

Applicant respectfully traverses the rejections under 35 U.S.C. §§ 102(e) and 103(a).

Accordingly, claims 18-33 and 35-38 are pending for consideration.

ALL CLAIMS ARE ALLOWABLE**Claims Comply With 35 U.S.C. § 112, first paragraph**

The Office rejects claims 18, 33, and 38 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

With respect to claims 18 and 33, Applicant has amended claims 18 and 33 to remove reference to a display operation part “detachably attached” to the image reader. Accordingly, Applicant respectfully submits that claims 18 and 33, as amended, meet the requirements of 35 U.S.C. § 112. Thus, the rejection of claims 18 and 33 under 35 U.S.C. § 112, first paragraph, is moot. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

With respect to claim 38, the Office alleges that the claim feature wherein the display operation part receives display information of at least two of a plurality of image readers from the management device and receives display information unique to the image reader from the image reader is not described in the specification. (Paragraph 2). Applicant respectfully disagrees.

Applicant describes, for example, that a system serves the left half of the display image

as the common setting to all the scanners 2-1 through 2-n, and provides it from the management server 1, and the system serves the right half as the unique setting to scanner 2, and provides it from the web server 25 at least at page 6, lines 18-24 of the specification and shown in FIG. 4A. As the claim feature wherein the display operation part receives display information of at least two of a plurality of image readers from the management device and receives display information unique to the image reader from the image reader is fully enabled by the specification, one of ordinary skill in the art would have understood that these portions of the specification support claim 38. Furthermore, it is respectfully submitted that Applicant's specification enables one of ordinary skill in the art to make and use the claimed invention. Accordingly, Applicant respectfully requests that the rejection of claim 38 under 35 U.S.C. § 112, first paragraph, be withdrawn.

In the event that Applicant's explanation above is not deemed to overcome the rejection of claims 18, 33, and 38 under 35 U.S.C. § 112, first paragraph, Applicant respectfully request the Examiner to contact Applicant's undersigned representative in order to advance prosecution of the application.

Rejections Under 35 U.S.C. § 102(e)

Claim 38 stands rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Roosen et al.* Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the Office has not established that *Roosen et al.* anticipates each and every feature of claim 38. Independent claim 38 recites, in part, "wherein the display operation part receives display information of at least two of a plurality of image readers from the management device and receives display information unique to the image reader from the image reader." *Roosen et al.* fails to teach or suggest at least these features of

claims 38.

The Office relies upon FIG. 1 and column 3, lines 23-27 of *Roosen et al.* to allege anticipation of this feature. (Paragraph 4.) Applicant respectfully disagrees. Column 3, lines 23-27 state the following:

FIG. 1 is a diagram showing a system according to the invention. The system includes a number of workstations 1, 2 and 3 for users, a central management unit 4 for coordinating scan orders, hereinafter referred to as ScanRequestManager (SRM), and a number of scanners 5, 6 and 7.

This portion of *Roosen et al.* fails to teach or suggest “wherein the display operation part receives display information of at least two of a plurality of image readers from the management device and receives display information unique to the image reader from the image reader,” as recited in claim 38. The Office seemingly relies upon the rejection under 35 U.S.C. § 112, first paragraph, discussed *supra*, and does not consider at least these claim features in alleging that *Roosen et al.* anticipates claim 38. As explained in M.P.E.P. § 706.03, the primary object of examination is to determine whether or not claims are patentable over the prior art, and that undue emphasis should not be given to non-prior art or “technical rejections.”

As pointed out in M.P.E.P. § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. Because *Roosen et al.* fails to teach or suggest each feature of independent claim 38, the rejection under 35 U.S.C. § 102(e) should be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Claims 18-28, 30-32 and 35-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hidaka et al.* further in view of *Roosen et al.* Claim 29 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hidaka et al.* further in view of

Meyer et al. Claim 33 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hidaka et al.* in view of *Roosen* and in further view of *Filepp et al.*

As amended, independent claim 18 recites, in part, an image reader including a storage part that stores a processed image, the processed image being retrievable by a management device. Similarly, claim 35 as amended recites, in part, an image reader including a storage part that stores the image read by the reading part, the image being retrievable by a management device. *Hidaka et al.* and *Roosen et al.*, whether taken alone or in combination, fail to teach or suggest at least these features of claims 18 and 35.

Hidaka et al. discloses a copy system 1 that includes a scanner 20 connected to copy server 10 (Col. 10, lines 6-9.) As shown in FIG. 1 of *Hidaka et al.*, the hard disk 13 is located in the copy server 10, not the scanner 20. (Col. 10, lines 10-17.) Similarly, *Roosen et al.* discloses a number of scanners 5, 6, and 7 connected to a scan request manager (SRM) 4. (Col. 3, lines 23-27.) As shown in FIG. 1 of *Roosen et al.*, data storage 9, which stores digitized documents, is connected to the SRM 4. (Col. 3, lines 37-45.) Thus, both *Hidaka et al.* and *Roosen et al.* fail to teach or suggest an image reader including a storage part that stores a processed image, the processed image being retrievable by a management device, as recited by claim 18, or an image reader including a storage part that stores the image read by the reading part, the image being retrievable by a management device, as recited by claim 35.

As to the rejection of claim 29, Applicant notes that the alleged rejection of claim 29 is improper. As claim 29 depends from claim 18, a rejection based on *Hidaka et al.* and *Meyer et al.* necessarily fails to teach or suggest the features acknowledged by the Office as being silent in *Hidaka et al.* (See rejection of claim 18).

As amended, independent claim 33 recites, in part, an image reader including a display

operation part, and the image reader receiving the operation instruction from the display operation part through the management device. Similarly, independent claim 37, as amended, recites, in part, at least one of the image readers including a display operation part that displays information and receives the operation instruction, and the at least one of the image readers receives an operation instruction from the display operation part through the management device. *Hidaka et al.* and *Roosen et al.*, whether taken alone or in combination, fail to teach or suggest at least these features of claims 33 and 37.

Hidaka et al. discloses a copy system 1 that includes a scanner 20 connected to copy server 10. (Col. 10, lines 6-9.) As shown in FIG. 1, the touch panel 18 and LCD panel 19 are located in the copy server 10, not the scanner 20. (Col. 10, lines 10-17.) Similarly, *Roosen et al.* discloses a number of scanners 5, 6, and 7 connected to a scan request manager (SRM) 4. (Col. 3, lines 23-27.) In *Roosen et al.*, the scanners are provided with their own operation control unit. (Col. 3, lines 28-33). At best, *Roosen et al.* is silent with respect to any network features of the control unit. Thus, *Hidaka et al.* and *Roosen et al.* fail to teach or suggest an image reader including a display operation part, and the image reader receiving an operation instruction from the display operation part through the management device.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Hidaka et al.* and *Roosen et al.*, whether taken alone or in combination, fail to teach or suggest each feature of independent claims 18, 35, and 37, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 19-32 depend from independent claim 18, and claim 36 depends from claim 35. Accordingly, claims 19-32 and 36 are also allowable for at least the reasons stated above. *Filepp et al.* and *Meyer et al.* fail to cure the deficiencies in *Hidaka et al.*

and *Roosen et al.* As *Hidaka et al.*, *Roosen et al.*, and *Filepp et al.*, whether taken alone or in combination, fail to teach or suggest each feature of independent claim 33, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.111 be entered by the Examiner, placing all pending claims in condition for allowance. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite the prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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